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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,033	03/20/2001	Hiroshi Sasaki	01154/LH	2754

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EXAMINER
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COLON, CATHERINE M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/813,033

Applicant(s)

SASAKI ET AL.

Examiner

C. Michelle Colon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The following is a Final Office Action in response to the communication received on July 8, 2005. Claims 1-30 are now pending in this application.

#### ***Response to Amendment***

2. Applicant's amendments to claims 1, 2, 11, 12, 14, 15, 24, 25, 27, 29 and 30 are acknowledged. The amendment to claim 2 is sufficient to overcome the 35 U.S.C. 112, second paragraph rejection set forth in the previous Office Action. Therefore, the 35 U.S.C. 112, second paragraph rejection of claim 2 is withdrawn.

#### ***Response to Arguments***

3. Applicant's arguments have been fully considered, but are found unpersuasive. In the Remarks, Applicant argues that Perkowski does not teach that the coded image includes ID information for identifying the printed matter. Examiner respectfully disagrees. In col. 5, lines 19-23, Perkowski discloses using UPC numbers, which are *read from bar codes printed* on a product. Thus, the UPC numbers identify the product and the bar code printed on the product. Additionally, in col. 4, lines 45-53, Perkowski discloses the URLs associated with the UPCs or UPNs are used to identify a variety of information related to a product such as product advertisements, product specifications, product warranties, product incentives where the product incentives include rebates, discounts and coupons. In col. 13, lines 1-9, Perkowski discloses imprinting UPCs on printed materials such as brochures and advertisements. Likewise, in col. 13, lines 10-

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38, Perkowski discloses imprinting UPCs on material to identify various services such as admission tickets to particular events. Thus, Examiner respectfully submits that Perkowski does teach that the coded image includes ID information for identifying the printed matter. It is also noted, that a majority of Applicant's arguments rely on limitations that exist in the preambles of the claims. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Thus, it is suggested to move pertinent limitations from the preambles of the claims into the bodies so that they may be given appropriate patentable weight.

Therefore, Applicant's arguments have been fully considered, but are found unpersuasive.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Perkowski (U.S. 6,064,979).

As per claim 1, Perkowski discloses a marketing research method for at least one of studying and analyzing a printed matter containing a visually readable printed image including at least one of characters and a photographic image and an optically readable coded image as obtained by encoding a URL to be used for specifying an information resource for the printed matter the Internet via an access device, wherein said coded image includes ID information for identifying the printed matter (col. 4, lines 45-53; col. 13, lines 1-9; URLs associated with the UPCs or UPNs are used to identify a variety of information related to a product such as product advertisements, product specifications, product warranties, product incentives where the product incentives include rebates, discounts and coupons.), and wherein copies of the printed matter are to be distributed to at least one of specified and unspecified persons, said method comprising:

storing said ID information and access information obtained for each access to the information resource as a result of an operation of optically reading said coded image of a reading device, restoring said URL and said ID information from the read coded image, and accessing said information resource corresponding to the restored URL via said access device connected to said reading device (col. 3, lines 51-54; col. 4, lines 45-53; col. 5, lines 19-31; col. 10, lines 27-32 and 37-40; The system discloses a UPC number readable by a bar code scanner, the UPC number linking to a website when it is scanned. The website is an information resource that provides information

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related to the UPC number such as product information. The UPC and ID information resource data are stored in a relational database.); and

at least one of studying and analyzing the printed matter, carried out by an issuer of said printed matter, by utilizing said ID information and the access information on the accesses as stored in said information resource (col. 12, lines 54-64; col. 14, lines 50-62; Users can study information related to a product accessed at a URL after scanning the product's UPC code. Manufacturers and advertising and marketing personnel may analyze the information associated with the UPC.).

As per claim 2, Perkowski discloses the marketing research method according to claim 1, wherein said information resource corresponding to said URL as restored from said coded image is an information resource adapted to allow at least one of studying and analyzing the printed matter (col. 14, lines 50-62; The information resource provided by the URL enables users to study information related to a product accessed through the URL.).

As per claim 3, Perkowski discloses the marketing research method according to claim 2, wherein said URL includes ID information for identifying said printed matter (col. 18, lines 39-43 and 52-55; URLs and UPCs are linked so that they point to very specific information files on the web related to the products associated with the printed matter.).

As per claim 4, Perkowski discloses the marketing research method according to claim 3, wherein said ID information includes at least one of a name of the printed matter, a type of the printed matter, a date of distribution of copies of the printed matter,

a distribution area of copies of the printed matter and a purpose of distribution of copies of the printed matter as identifiable information (col. 10, lines 47-67; The ID information is associated with a variety of product information such as promotions, sales and distribution of the product.).

As per claim 5, Perkowski discloses the marketing research method according to claim 1 wherein said URL includes ID information for identifying said printed matter (col. 18, lines 39-43 and 52-55; URLs and UPCs are linked so that they point to very specific information files on the web related to the products associated with the printed matter.).

As per claim 6, Perkowski discloses the marketing research method according to claim 5, wherein said ID information includes at least one of a name of the printed matter, a type of the printed matter, a date of distribution of copies of the printed matter, a distribution area of copies of the printed matter and a purpose of distribution of copies of the printed matter as identifiable information (col. 10, lines 47-67; The ID information is associated with a variety of product information such as promotions, sales and distribution of the product.).

As per claim 7, Perkowski discloses the marketing research method according to claim 1, wherein said coded image further contains a browser starting program for starting a browser for said access device (col. 6, lines 19-25; col. 7, lines 6-14).

As per claim 8, Perkowski discloses the marketing research method according to claim 1, wherein said printed matter is one of a newspaper, a magazine, a book, a journal, a pamphlet, a catalog, a leaflet and a ticket (col. 10, line 29; col. 13, lines 4-5 and 20-28).

As per claim 9, Perkowski discloses the marketing claim 1, wherein research method according to if said printed matter carries at least one of a plurality of articles and advertisements and the at least one of each article and each advertisement shown on the printed matter is provided with a printed coded image, the URL contained in each of the coded images includes ID information for identifying the at least one of the article and the advertisement, whichever appropriate (col. 12, lines 41-48; col. 13, lines 4-5 and 20-38; The system links the ID information to the appropriate URL. For example, if the ID information is for a ticket to an event, the URL links to information related to the event.).

As per claim 10, Perkowski discloses the marketing research method according to claim 1, wherein said information resource is an information resource belonging to the issuer of the printed matter (col. 10, lines 37-40; The information resources can link to information related to manufacturers of a product related to the UPC and URL.).

As per claim 11, Perkowski discloses the marketing research method according to claim wherein a plurality of printed matters containing a same advertisement is involved and the advertisement of each of the printed matters is accompanied by a coded image specific to the printed matter, said information resource is an information resource belonging to a sponsor of the advertisement (col. 12, lines 24-28 and 54-62).

As per claim 12, Perkowski discloses the marketing research method according to claim 1, wherein the access information on the accesses to the information resource includes at least one of a number of accesses, date and time of each of the accesses



and data on each person who accessed the information resource (col. 13, lines 20-38; The UPC data can demark service related information such as attendance to an event.).

As per claim 13, Perkowski discloses the marketing research method according to claim 1, wherein said coded image includes information on at least one of a sound, an image and a text in addition to said URL (col. 14, lines 50-62; The URL links to text related to the product associated with the UPC.).

Claims 14-30 recite substantially similar subject matter as claims 1-13 above. Therefore, claims 14-30 are rejected on the same basis as claims 1-13 above.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Tai (U.S. 4,908,761) discusses a system for identifying product purchasers and predicting consumer promotional behavior response patterns using bar codes; and
- De Lapa et al. (U.S. 5,822,735) discusses a focused coupon system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Tarae (formerly, C. Michelle Colon) whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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cmc

September 15, 2005

  
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